Remarks

Claim Objections

The Examiner has objected to the claims because the lines are crowded too closely together. Accordingly, this response provides substitute claims with appropriate spacing on good quality paper.

Claim Rejections

The Examiner has rejected certain claims without fully establishing a prima facie case of obviousness. That is, the Examiner has not demonstrated all elements of several claims that were nevertheless rejected under §103. It is well known that "[i]f the examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent." See *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992).

While the exact elements of a prima facie case of obviousness have not been conclusively determined by the courts, it is apparent that at a minimum all elements of each rejected claim must in some way be accounted for by the Examiner. In claims 3-8, 10-15, 18-23, 25, and 28-34 this has not been done.

In the rejection of claim 3 Examiner fails to indicate a limitation of claim 3 taken from claim 2, on which claim 3 is dependent. The limitation is in the first computer module and requires it to have a "means for creating a natural language report and a searchable database from said medical information." Claim 3, dependent upon claim 2, would also require a means for creating a natural language report, yet Examiner does not address this limitation in his rejection.

Similarly, claims 4, 5, 6, 7, 8, 10, 11, 12, 13, 14, 15, and 16 all include the above indicated limitation from claim 2 and similarly, the Examiner has not mentioned this limitation in his rejection of any of these claims.

A per claims 1 and 26, Examiner argues that Brown discloses a system for gathering and managing patient medical data, while Campbell discloses a system having a microprocessor having loaded in memory a second computer module having a means for creating customized data entry screens for use by a first module. In reliance upon Examiner's finding, applicant cancels claims 1 and 26, and amends claims 2 and 27 so as to make them appear in independent form and include all limitations from former claims 1 and 26, respectively.

Claim 2, as amended, should now be allowed. In the rejection of claim 2 the Examiner has relied upon Friedman (U.S. Pat. 6,055,494) as evidence that a means for creating a natural language report and searchable database from medical information is well known in the art. See office Action of January 4, 2006, stating that "Friedman suggests means for creating a natural language report and a searchable database from said medical information." Examiner's representation of the subject matter taught by Friedman is incorrect. Friedman instead teaches the opposite, that is, the computer processing of natural-language input. Natural language is inputted and through "phrase parsing" (Friedman Col. 1, line 52) is rewritten. Friedman is further characterized by an example given in Col. 2 lines 51-53, where a "regularizer" is defined to generate the phrase "enlarged heart" from each of the natural language phrases "heart is enlarged", "enlarged heart", "heart shows enlargement" and "cardiac enlargement."

Finally, Friedman's stated objective seems to reinforce Applicant's current interpretation of Friedman. In Col. 1, lines 9-16, Friedman states that while natural language is convenient in interpersonal communication, the same is not true with computers. *See* WMS Gaming Inc. v. International Game Technology, 51 USPQ2d 1385 (Fed. Cir. 1999).

The purpose of applicant's invention is to create such natural phrases from very short abbreviated inputs that are made on a handheld computer, where time and space

constraints prevent the user from inputting long natural language sentences. The cited combination of Brown (U.S. Pat. 6,168,563) and Friedman in fact teaches away from the claimed limitation "creating a natural language report." McGinley v. Franklin Sports Inc. (60 USPQ2d 1001 (Fed. Cir. 2001), stating "[w]e have noted elsewhere, as a 'useful general rule,' that references that teach away cannot serve to create a prima facie case of obviousness." Because Friedman does not teach the claimed limitation in applicant's claim 2, applicant respectfully requests that claim 2 and all claims dependent upon it be allowed.

The Examiner has used Friedman in a similar way to reject claims 9. 17 24. 27. 34. 35. 37, and 39. Rather than recite the arguments set forth with regard to claim 2, applicant notes the similarity of the rejection and likewise requests claims 9, 17, 24, 27, 34, 35, 37, and 39 be allowed for the same reasons cited in the request for the allowance of claim 2.

The Examiner argues that claims 18-23, 25, and 28-33 recite the underlying process of the elements of claims 3-8 and 15. Arguments have been put forth in this office action response for the allowance of claims 3-8 and 15, obviating the need to respond directly to rejections Examiner argues recite the same element. Applicant makes no statement to concur or agree with Examiner regarding the coverage of claims 18-23, 25, 28-33.

Newly Amended Claims

As detailed above, applicant has amended claims 2 and 27 so as to rewrite them in independent form and to incorporate all limitations from claims upon which they formerly depended.

Applicant additionally amends claims 36, 38, and 40, adding limitations to each.

Claims 39, and 40 have been amended to delete the unintentionally repeated word "information" appearing on the original application.

Conclusion

In light of the remarks and amendments detailed above, which address each rejection and objection by the Examiner, Applicant respectfully requests reconsideration and allowance of the application.

Dated: 5 June 2006   By:

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